

Appln. No. 09/865,229
Amendment dated July 1, 2003
Reply to Office Action of March 28, 2003

REMARKS/ARGUMENTS

Reconsideration of the above-identified application respectfully requested.

Claim Amendments:

Claims 1 and 3-5 have been amended, inserting the word "structural" before the term "automobile part".

Finality of the Rejection:

With the present office action, the Examiner has conducted a new search, cited a new reference, and introduced a new ground of rejection. Namely, the Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,154,898 ("Engles") in view of newly cited U.S. Patent No. 3,166,188 ("Koester"). Despite this new ground of rejection, the action has been made final.

Making a new ground of rejection final is appropriate only where the new ground of rejection is necessitated by applicant's amendment of the claims or based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17(p). MPEP § 706.07(a). Applicants did not submit an information disclosure statement after receiving the last office action, therefore, the only permissible reason for making the present office action final would be because of Applicants' amendment of the claims. Claim 4, which is the subject of the new ground of rejection, was amended from "parts are one or more of window glass, door panel, hood, or fender" to -- part is selected from the group consisting of window glass, door panel, hood, fender or combinations thereof --. This new language was adopted at the suggestion of the Examiner and goes to form rather than substance. The claim has not changed in either scope or content. Claim 4 is dependent on independent claim 1. The only amendments to claim 1 were for clarification and to provide proper antecedent basis (i.e., labeling the third step as "c" rather than "b"; amending steps b and c to recite "paperboard" rather than "laminated paperboard" to be consistent with step a; changing "said an automobile part product" in step c to "said automobile part" to be consistent with step b). These amendments also go to form rather than substance and would not warrant a new search, as the scope and content of the invention as claimed did not change.

The MPEP clearly provides that "the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied." MPEP § 706.07. This provides the applicant with a full and fair hearing and enables a clear issue between the applicant and the Examiner to be developed before appeal. *Id.* The Examiner's initial search,

Appln. No. 09/865,229
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including, *inter alia* claim 4, should have encompassed all the prior art relevant to the claim as amended. As such, Applicants respectfully request that the finality of the rejection be withdrawn so that the rejection can be fully addressed prior to appeal.

Claim rejections:

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Engles. The Examiner considered Applicants' previous arguments regarding Engles but has found them unpersuasive. In particular, in response to Applicants' argument that Engles teaches away from the use of paperboard, the Examiner again cites language in Engles (line 15) suggesting that use of paperboard material as a backing is convention in nature.

Applicants respectfully request that the examiner reconsider the full teaching of Engles. There is no question about the fact that the invention disclosed in Engles does not include all of the features of claim 1. However, to overcome what's missing, the examiner looks to prior art cited in the background of Engles. This combination is, in effect, a §103 rejection rather than a §102 rejection. Regardless of the how the rejection is delineated, Engles alone or as modified by the prior art cited in Engles does not disclose the invention.

Engles discloses in its background that, "Conventional skin packages which utilize a paperboard backing are not water impervious, tend to curl under stress, and require the use of an adhesive to secure a firm bond between the backing and the film overlay." Col. 1, lines 15-18. Thus, the prior art plastic skin packages consist of a paperboard backing, a film, and an adhesive to secure the film to the backing. Engles overcomes the disadvantages of the prior art packaging by using a backing of non-porous foamed plastic which is compatible with the film overlay. Col. 1, lines 19-23. Engles' plastic skin packages are made in conventional vacuum forming apparatus, but no adhesives are required to form strongly bonded products. Col. 1, lines 67-70. In summary, both the Engles prior art and Engles are concerned with three elements: a backing, a film, and an adhesive. Engles differs from the prior art for all three of these elements. Engles utilizes foam, the prior art paperboard. Engles utilizes a vacuum formable plastic, the prior art does not. Engles eliminates an adhesive, the prior art requires it.

Turning to the rejection, it should first be noted that Engles alone clearly does not disclose all of the limitations of the claimed invention. The notably missing element is a paperboard backing. In particular, Engles specifically teaches away from paperboard because of its noted disadvantages, i.e., not impervious to water, tendency to curl, etc. The choice of backing for Engles is not without significance. Paperboard and foam are not interchangeable or equivalents. The backing of Engles was carefully chosen as foamed plastic to be compatible with the film overlay. With this combination, no adhesive is required so the packaging can be vacuum formed.

Appln. No. 09/865,229
Amendment dated July 1, 2003
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Second, it is improper to pick and choose among the teachings of the prior art to modify Engles to get the claimed invention. To combine Engles and the Engles prior art, the Examiner selects from the prior art only the paperboard backing and rejects the other two components, namely, the film and the adhesive. The Examiner then combines that backing with the film and lack of adhesive of Engles. There is no teaching or suggestion that such a combination would be operable, and, in fact, Engles suggests that it would not be. The Examiner is substituting the very element that Engles states does not work. Clearly, it is improper to read a reference in such a way as to render the invention inoperable. Either alone or in combination with the prior art cited in its background, Engles does not disclose or suggest the claimed invention.

While the present invention certainly will work for small parts, the essence of the invention is the ability to package structural automobile parts that may be large, heavy, breakable, or all of the above. See application, page 4, lines 10-19. In order to clarify the invention, the claims has been amended to specifically recite this feature. As noted above, Engles, Jr. teaches away from paperboard even for small articles (i.e., a spark plug), let alone structural automotive parts. With respect to the prior art cited in the background of Engles, there is no disclosure of what type or size parts are contained within conventional skin packaging. In light of the above, Applicants respectfully submit that claim 1 is patentable over Engles. Claim 3, dependent on claim 1, also is patentable for the same reasons.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Engles in view of U.S. Patent No. 3,166,188 ("Koester"). The Examiner cites Engles as disclosing the invention as claimed except for the packaging of an automobile part comprised of window glass, door panel, hood, fender, or combinations thereof. The Examiner cites Koester as disclosing that it is well-known to package a windshield in a package formed from fiberboard or other similar material. The Examiner concludes that it would have been obvious to provide the invention of Engles with the packaging means as taught by Koester for the purpose of protecting a part during shipping.

As described above, Engles does not disclose the invention as claimed. Engles does not disclose the use of paperboard nor the packaging of a structural automobile part, such as window glass, door panel, hood, fender, or combinations thereof. Koester does not make up for these deficiencies. Koester discloses packaging large glass items, such as windshields, in a rectangular sheet of fiberboard. The fiberboard is folded along a centerline to form a support panel and a cover. Col. 2, lines 19-22. To hold the glass firmly in place between the panels, banding strips of metal or tape are wrapped around the folded panels. Col. 3, lines 17-22.

Applicants first respectfully submit that there is no motivation or suggestion to combine Engles and Koester. Koester teaches nothing more than to provide a given material, namely

Appln. No. 09/865,229
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fiberboard, on either side of a part to be shipped. Engles teaches laminating a part to foam. One patent teaches that the item to be shipped should be surrounded by paperboard, while the other teaches to use foam instead of paperboard because of the disadvantages of paperboard. If one were looking to improve the invention of Engles, which teaches away from paperboard, why would the skilled artisan look to a patent extolling the virtues of paperboard? Engles discourages use of paperboard for even one side, while Koester demands that paperboard be used on both sides.

Even assuming that the references could properly be combined, what would the resulting combination be? Applicants suggest that combining the packaging teachings of Koester with the invention of Engles would result in a part packaged between two pieces of foam. This clearly is not the claimed invention. If the Examiner's suggestion is that the glass windshield of Koester could be substituted for the spark plug of Engles, that combination also does not disclose the invention. As noted in detail above, Engles does not disclose laminating a part to paperboard. Further, there is no teaching or suggestion that the invention of Engles would work with a large, easily-damaged part like a windshield. Engles discloses only the packaging of a spark plug, which is a relatively rigid and rugged part having a ceramic insulator partially surmounting a metal shank. If Engles teaches away from paperboard for even a small part, the undesirability of paperboard would be even greater for a large part, whose fragility or dentability would be proportional to its size. Finally, there is no teaching or suggestion to replace the foam of Engles with the paperboard of Koester. "A modification of a prior art patent or device which would render that device unworkable for its intended purposes cannot be said to suggest such a modification." *National Tractor Pullers Assn., Inc. v. Watkins*, 205 U.S.P.Q. 892, 911 (N.D. Ill. 1980). Engles clearly teaches against the use of paperboard. Additionally, nowhere does Koester disclose the benefits of laminating and, as noted above, Koester requires that the objected be supported by paperboard on either side. "It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference thoroughly suggests to one of ordinary skill in the art." *In re Wesslau*, 147 U.S.P.Q. 393 (CCPA 1965); *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986); *In re Davis*, 26 F.3d 139, *3 (Fed. Cir. 1994) ("[A]ll of the relevant teachings of the cited references must be considered in determining what they fairly teach to one having ordinary skill in the art.").

With the present invention, Applicants reject the teaching of Engles that paperboard is bad. They reject the teaching of Engles that foam is better. They reject the teaching of Koester that an object must be supported on both sides by paperboard. Rather, Applicants invention

Appln. No. 09/865,229
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calls for a structural automotive part shrink wrapped to paperboard. Given the teachings of Engles and Koester, it is surprising and unexpected that a paperboard backing provides such structural integrity. However, the invention is suitable for unbreakable structural automobile parts, such as hoods, fenders, and doors, which can become scratched, dented, and abraded, or breakable structural automobile parts, such as glass windshields.

For these reasons, Applicants respectfully submit that claim 4 is patentable over Engles, Koester, and the combination of the two.

Claims 2 and 5, each dependent on claim 1, are patentable for the reasons given in connection with claim 1.

In order to permit the examiner to fully consider Applicants amendment and response, Applicants submit herewith a request for a one month extension of time up to and including July 28, 2003 to file a notice of appeal.

In view of the remarks submitted herewith, Applicants request that the finality of the rejection be withdrawn and that the claims be allowed and passed to issue. If an allowance is not forthcoming, please enter these amendments for purposes of appeal.

Respectfully submitted,

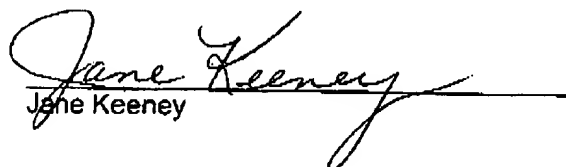
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CERTIFICATE OF FACSIMILE

I hereby certify that this Amendment and Response After Final is being sent on July 1 by facsimile to the Honorable Commissioner of Patents at facsimile number 703-872-9303 as an after final communication.



Jane Keeney